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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/071,801 | 02/07/2002 | Stuart D. Carlisle | 1123K | 2855 |
| 7590 12/04/2003 | | | | |
| Tyco Healthcare Group LP 15 Hampshire Street Mansfield, MA 02048 | | | | |
| EXAMINER YOON, TAE H | | | | |
| ART UNIT PAPER NUMBER | | | | |
| 1714 | | | | |

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,801

Applicant(s)

CARLISLE ET AL.

Examiner

Tae H Yoon

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 15 and 21-26 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 16-20 and 27-33 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-162)
- 6) ☐ Other:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim is indefinite since it recites improper hybrid format dependent on the method claim 27 and tape claim 21.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 9, 11, 13, 16, 17 and 29-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Korpman et al (US 5,760,135).

Korpman et al teach an adhesive composition and a tape thereof comprising an isoprene-styrene block copolymer, a styrene-ethylene-butylene-styrene block copolymer, a phenol-formaldehyde curing agent, a phenolic antioxidant and a hydrocarbon tackifier at col. 3, lines 31-36, col. 4, lines 47-51 and 65-66, col. 5, lines 40-41 and line 56 to col. 6, line 56. The use of curing accelerators containing zinc is taught at col. 4, lines 52-61, and of fillers such as zinc oxide also meeting said accelerators is taught at col. 5, line 3.

Thus, the instant invention lacks novelty.

Claims 1-9, 11, 13, 16-20 and 29-32 are rejected under 35 U.S.C. 103(a) as obvious over Korpman et al (US 5,760,135) in view of EP 1 043 373.

The instant invention further recites a polyethylene backing and antimicrobials over Korpman et al. However, Korpman et al teach the use of an adhesive on skin and a film substrate at col. 6, lines 46-57. EP teaches the art well known polyethylene backing in [0030].

It would have been obvious to one skilled in the art at the time of invention to utilize an antimicrobial in the adhesive tape of Korpman et al since Korpman et al teach the use of an adhesive on skin which would require protections against any contamination or to use the art well known polyethylene backing of EP in Korpman et al since Korpman et al teach the use of substrates.

Claims 1-9, 11, 13, 16, 17 and 27-32 are rejected under 35 U.S.C. 103(a) as obvious over Korpman et al (US 5,760,135) in view of Chen (US 5,405,703)

The instant invention further recites the use of an adhesive tape for air ducts over Korpman et al, but such practice is well known in the art as taught by Chen, abstract. Korpman et al teach an adhesive foil at col. 6, line 56 and said foil is known to be a metal in the art.

It would have been obvious to one skilled in the art at the time of invention to utilize an adhesive foil of Korpman et al in connecting air ducts taught by Chen since Korpman et al teach an adhesive foil and since the use of an adhesive tape for air ducts is well known in the art as taught by Chen.

Claims 1-9, 11-13, 16, 17 and 29-33 are rejected under 35 U.S.C. 103(a) as obvious over Korpman et al (US 5,760,135) in view of Chiang et al (US 3,956,223) or Yu et al (US 5,453,465).

The instant invention further recites a brominated phenol-formaldehyde curing agent over Korpman et al. However, such curing agent is well known as taught by Chiang et al (col. 4, lines 1-9) and Yu et al (col. 9, line 66 to col. 10, line 1).

It would have been obvious to one skilled in the art at the time of invention to utilize a brominated phenol-formaldehyde curing agent of Chiang et al or Yu et al in Korpman et al since said curing agent is well known in the art and since Chiang et al and Yu et al equate brominated and non-brominated phenol-formaldehyde curing agents absent showing otherwise.

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Claims 14, 15 and 21-26 are allowed since the mixture reciting five different rubber components of claim 14 and the tape having a double layer of an adhesive of claim 21 wherein the first layer has reinforcement would not be obvious over the art of the record.

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,514,721 teach the use of reclaimed rubber in thermoplastic compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon

Primary Examiner

Art Unit 1714

THY/December 1, 2003